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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,234	10/20/2003	Charles DeGennaro JR.	3006.1001	4075

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EXAMINER	
PIERCE, WILLIAM M	
ART UNIT	**PAPER NUMBER**
3711	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

CT

Office Action Summary	Application No.	Applicant(s)	
	10/689,234	DEGENNARO, CHARLES	
	Examiner	Art Unit	
	William M. Pierce	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3,4,6,16-24 and 26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3,4,6,16-24 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

This claims sets forth rules that are not positive action steps that one can perform that would further limit the claimed invention.

Claim Rejections - 35 USC § 103

Claims 4, 6, 16-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over What is Claymania in view of Wire Sculpture as set forth in the previous office action. .

"Claymania shows making a sculpture conforming to indicia on cards out of clay within a given amount of time. While the use of wire is not discussed, the prior art teaches that wire is a well known media for making a sculpture. To have replaced the clay of Claymania with wire would have been an obvious matter of choosing one known media for that of another. Applicant has not shown his choice of media to be critical by solving any particular problem or producing any unexpected results. As to claim 4, providing individual colorcoded game paraphernalia to player is old and well known. As to claim 19, having cards categorized to different levels of difficulty is known in question and answer type games. Claims 22 and 23 reflect only rules of play that are analogous to functional limitations in an apparatus claim in that they fail to further limit the claim by reciting a positive physical step that can be performed. As such recitation fail to distinguish over the art of record. Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph as set forth above.

While applicant remarks that his game is "entirely different" from Claymania, the examiner does not agree for the reasons and motivation set forth above. The ability to make shapes of both clay and wire are considered fairly taught in the art. Likewise the use or not allowing the use of body language in such a game (such as charades) is not something that was invented by applicant and is fairly taught by the art as a whole. "

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claymania in view of Wire Sculpture in view of Cohen as set forth in the previous office action.

"In Claymania, prevailing players are recorded by being awarded a token that marks a space. However, Cohen teaches that it is known in question and answer type games to have moves being awarded for correct answers to the cards and die and spinners are well known equivalents with respect to random number generators. To have recorded the prevailing game events of Claymania with a spinner that awarded advancement of a players playing piece would have been obvious in order to record game events of a player."

Conclusion

Applicant's arguments filed 12/3/07 have been fully considered but they are not persuasive.

Applicant argues on pg. 14, that his claims have been amended as a "method of treatment using an educational and therapeutic game". He argues that a player using wire strengthens his muscles and stimulates logic and reasoning. While this may be true, the same argument can be made for the game of Claymania. A player manipulating the clay strengthens the muscles in the hands and his logic and reasoning while playing the game. This is an expected result of playing a game where physical dexterity is required. Applicant has not shown where the use of a wire over that of clay (or folding paper, drawing and etc.) solves any particular problem or produces any unexpected results. The folding of a wire by a patient in the play of the game

accomplishes improvements in motor and cognitive skills in a way that would be expected to one of ordinary skill. There is no evidence that this method produces any unexpected results or solves a problem in the area of therapy. Here the results brought forward by applicant are inherent in the prior art and would be expected by one of ordinary skill in the art. The intended use of applicant's invention for therapy instead of pure entertainment do not distinguish it. Court held that the intended use of was of no significance to the structure and process of making. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) and statements of intended use in an apparatus claim did not distinguish over the prior art apparatus. If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Where applicant argues that Wire Sculpture is an "art form", so too is working with clay. Claymania has taken the "art form" of working with clay and formed a game. Clearly one would consider other art forms such as painting, drawing, wire sculpture, paper folding and etc. One of ordinary skill would have found it obvious to have tried other art forms in place of clay. This position is supported by the recent decision *KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. APR. 30, 2007).*

With respect to the colored game tokens, the fact that the prior shows more than is being claimed does not distinguish the claimed invention from it. The claims are constructed in open language "comprising" such that the prior art only needs to show what is being claimed. As to the "flexible wire", all wire is deemed flexible. The degree

of flexibility is not a limitation in the claim and as such this argument cannot be persuasive.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

WILLIAM M. PIERCE
PRIMARY EXAMINER